



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,263	03/26/2004	Tomoyuki Ohtani	15689.45.1.1	1121
22913	7590	07/13/2007		
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			EXAMINER CUMMING, WILLIAM D	
			ART UNIT	PAPER NUMBER
			2617	
			MAIL DATE	DELIVERY MODE
			07/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/810,263

Applicant(s)

OTTANI, TAMURA, & SATO

Examiner

WILLIAM D. CUMMING

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6, 11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/230,956.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 11, and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if at the center does or does not establish one or more communication branches and is doing diversity handover because the method is only "trying."

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 6, 11, and 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/55,174. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current application is claiming branch candidates and the copending application is claiming base station candidates. Both applications state that the base stations are part of the branches and both claims are doing basically the same functions of diversity handover.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. These nonstatutory double patenting rejections **CANNOT** be held in abeyance. Applicant **MUST** either traverse the nonstatutory double patenting rejection or file a terminal disclaimer. If applicant does **NOT** either traverse the nonstatutory double patenting rejection or file a terminal disclaimer it will be consider a **DELIBERATE** non-responsive response and the application maybe **ABANDONED**.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 6, 11, and 13-16 are have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

10. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

#### 11. **Electronic Notification of Outgoing Correspondence (e-Office Action)**

Effective December 16, 2006, the United States Patent and Trademark Office (Office) will begin a pilot program to provide a limited number of Private PAIR users with the option of receiving electronic notification of some outgoing correspondence related to their US patents and US national patent applications retrievable through Private PAIR instead of a paper mailing of the correspondence. Patent Cooperation Treaty (PCT) applications will not be included in this pilot.

Participants in this pilot program will no longer receive paper mailings for most correspondence originating from a Technology Center. However, since several areas of the Office have independent mailing processes, pilot participants will continue to receive paper mailings for correspondence originating from several areas of the Office including, but not limited to: Office of Initial Patent Examination, Petitions, PCT, Appeals, Publications, Interference, and Reexamination.

A Private PAIR user will be able to opt-in to receive electronic mail message (email) notifications of outgoing correspondence by selecting the appropriate choice on the Customer Number Details screen for a customer number associated with a correspondence address after logging in to Private PAIR and providing between one and three email addresses to be used for these notifications. The Private Pair user must be a registered patent attorney or agent of record, or a pro se inventor who is a named inventor in the application associated with the customer number through which Private PAIR is accessed. The Office will then send a notification to each provided email address if a new outgoing correspondence has been prepared for the patents or patent applications associated with the user's Customer Number. Each email notification will list all applications, associated with the corresponding Customer Number, in which new outgoing correspondence was prepared for the corresponding electronic application files within the preceding 24 hours. Each email notification will be entered into the corresponding application files. The new outgoing correspondence will become available for viewing and downloading through Private PAIR within two business days of the date of the email notification.

Applicants will have the ability to opt-in or opt-out of receiving electronic notification of Office actions at any time. However, the status of each individual outgoing

correspondence, whether electronic or paper, will be determined at the time of the printing of the form PTOL-90 cover sheet (at the time the outgoing correspondence becomes available for viewing, i.e., the date indicated on the correspondence).

The email notification described above will be sent after the Office action has been prepared and entered into the record. The period for reply to any Office correspondence to which a reply is required will commence on the date indicated on the outgoing Office such outgoing correspondence for all other purposes (e.g., 37 CFR 1.71(g)(2), 1.97(b), 1.701 through 1.705). The Office communication will become available for downloading and viewing through Private PAIR on the date indicated on the correspondence.

If none of the documents in each of the applications listed in the email notifications are viewed or downloaded through Private PAIR within seven calendar days after the emails are sent, a courtesy postcard notifying the applicant of the availability of electronic Office action will be mailed to the correspondence address associated with the applicant's corresponding Customer Number for each of those applications. The mailing of a courtesy postcard will not restart the time period for reply, and the period for reply to any outgoing Office correspondence to which a reply is required will continue to be measured from the date indicated on such outgoing Office correspondence.

Please note that the email notification procedure outlined above is simply an automated email sent by the Office to alert applicant that an official Office correspondence has been entered in the official record that will be available for viewing via private PAIR. It is not an email sent by the examiner and does not alter the Office policy prohibiting an applicant or examiner from engaging in improper email correspondence. See MPEP section 502.03.

The e-Office Action Pilot Program will begin with a limited number of participants. The Pilot Program will last approximately six months. Upon the conclusion of the pilot program the success of the pilot will be evaluated. At that time decisions will be made as to whether or not to make modifications to the e-Office action program and whether or not to permanently implement the program.

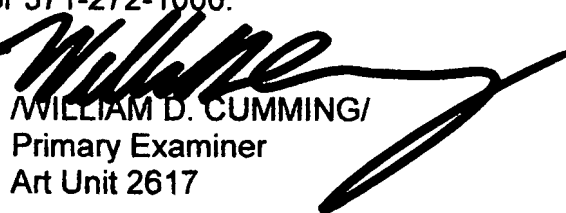
Thus, if the pilot program is successful and a decision is made to permanently implement the program, it is expected that the e-Office Action Program will go into full production sometime around June 2007 at which point the program will be open to all users (registered patent attorney or agent of record, or a pro se inventor who is a named inventor in the application associated with the customer number through which Private PAIR is accessed) having a Customer Number and access to Private PAIR.

For further information please contact the Patent Electronic Business Center (EBC) 866-217-9197 (toll-free) or 571-272-4100 Monday through Friday from 6 a.m. to 12 Midnight Eastern Time or send e-mail to [ebc@uspto.gov](mailto:ebc@uspto.gov)  
Date 12/19/2006

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday 11:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
/WILLIAM D. CUMMING/  
Primary Examiner  
Art Unit 2617



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

---

William Cumming  
Primary Patent Examiner  
[William.Cumming@uspto.gov](mailto:William.Cumming@uspto.gov)